
United States Court of Appeals

For the Ninth Circuit

No. 22495 ✓

PROLER STEEL CORPORATION, INC.,

Plaintiff-Appellant,

v.

LURIA BROTHERS & COMPANY, INC., and
LIPSETT STEEL PRODUCTS, INC.,

Defendants-Appellees.

BRIEF OF DEFENDANTS-APPELLEES

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BRIEF OF DEFENDANTS-APPELLEES

I. STATEMENT OF THE CASE

A. Nature of the Action

This is an appeal from the granting of summary judgment to appellees in a suit brought by appellant for infringement of the Proler reissue patent Re. 25,034 (herein called the Proler reissue patent), issued August 29, 1961 (A. 5a; R. 335).*

* Throughout this brief A. designates the page of the appendix which accompanies this brief, R. the page of the record on appeal and FF the findings of fact of the Court below.

The Proler reissue patent is for a process for producing fragmentized ferrous scrap, principally from old automobiles. Appellees have since September 1963 produced a fragmentized ferrous scrap called Lurmet at their plant in Vernon, California. Appellant charges that the process used to manufacture Lurmet since but not prior to May 1965 infringes process claim 9 of the Proler reissue patent (R. 56).

Claim 9 is for a process and not a product. The fragmentized ferrous scrap, Lurmet, is not charged to infringe claim 9 or any other claim of the Proler reissue patent.

Appellees' motion for summary judgment was briefed, argued on September 18, 1967, and granted on September 27, 1967, with findings of fact and conclusions of law (A. 20a; R. 610). Appellant then moved for reconsideration. The motion for reconsideration was briefed, argued on November 20 and 21, 1967, and denied after the close of argument (see A. 33a).

B. The Proler Reissue Patent

The Proler reissue patent (A. 5a; R. 335) is a reissue of now surrendered U. S. patent No. 2,943,930 (appellant's Ex. Y, herein called the original Proler patent), issued July 5, 1960, on an application which was a continuation of an abandoned application Serial No. 677,514 (herein called the abandoned Proler application), filed August 12, 1957.

The abandoned Proler application, the original Proler patent and the Proler reissue patent all describe in very general terms a process for upgrading raw ferrous scrap

using conventional equipment. The process includes the steps of shredding the raw ferrous scrap in a hammermill, separating the ferrous fragments from the nonferrous material using a magnetic separator, roasting the ferrous fragments in a furnace or kiln at a temperature in the range of 1300° F. to 1800° F. to burn off adhered nonferrous material, and compacting the ferrous fragments, preferably while still hot, between rolls to increase the density.* The process also includes as optional steps, trommeling the scrap after roasting and before compacting and a second magnetic separation after compacting (A. 5a, column 2, line 50, and column 3, line 8; R. 335).

Appellant does not assert that the hammermill, magnetic separator, furnace or rolling mill is novel. On the contrary, in response to an interrogatory appellant stated that the steps of the process could be practiced using a hammermill, a magnetic separator, a furnace and a rolling mill which were conventional at the time that the Proler process was conceived (R. 48-49).

All of the process claims filed and prosecuted in the abandoned Proler application and in the continuing application which issued as the original Proler patent recited the roasting step (R. 360-482).

During the prosecution of the abandoned Proler application and the application which issued as the original Proler patent the roasting step was characterized by ap-

* A reduction in size of the fragments results in an increase in "density", that is, the weight of a cubic foot of scrap fragments. If the pieces are smaller more of them can be placed in a cubic foot unit because they fit together more snugly with fewer interstices.

pellant's attorneys as "of major importance" in the process (R. 436), "to a large extent responsible for the tremendous commercial success" of the process (R. 396), and a step which distinguished the Proler process from the prior art patents (R. 379-401; 435-473). Some of the statements emphasizing the importance of the roasting step are set forth in FF 2.3 (A. 21a-24a; R. 611-615). All of the process claims which issued in the original Proler patent were limited to a process which included the roasting step.*

Five months after the original Proler patent issued, Proler filed an application to reissue the patent and broaden it by the addition of claims 9 and 10 which were not limited to a process which included the roasting step.

Claim 9 of the Proler reissue patent, the only claim which appellant charges is infringed, describes a process for refining raw ferrous material comprising

1) "shredding the raw material,"

2) "separating the more ferrous bearing shredded material from the less ferrous bearing shredded material" and

3) "individually compacting and balling up the pieces of the more ferrous bearing shredded material to densify it while maintaining the individuality of the separate pieces, whereby a fluent mass is obtained."

The step 1 describes the ordinary function of a conventional hammermill in fragmentizing raw ferrous scrap; the step 2 describes the ordinary function of a conventional magnetic separator in separating the ferrous frag-

* Claims 1 through 8 of the Proler reissue patent.

ments from the nonferrous material; and the step 3 describes the ordinary function of a set of conventional rolls for compacting between them those fragments that are malleable (R. 48-49).

C. The Prior Art

The prior art relied on by appellees in support of their motion for summary judgment is conceded by appellant and raises no issue of fact.

There is no dispute between the parties that hammer-mills, magnetic separators and rolling mills were well known to scrap processors long before April 1957, the alleged date of the conception of the process of the Proler reissue patent.

The steps of shredding or fragmentizing raw automobile scrap in a hammermill and then magnetically separating the ferrous fragments from the nonferrous material are steps which had been practiced by the Los Angeles By-Products Company of Los Angeles, California, during the 1930s and 1940s (R. 54; appellant's brief p. 12). To be sure, the Los Angeles By-Products Company also generally compacted the fragmentized scrap in bales, but only after first producing a clean, fragmentized ferrous scrap.

The Los Angeles By-Products process is described in the Gregg patent No. 2,059,229 (A. 7a; R. 339) for "Method of Preparing Discarded Automobile Fenders and Similar Material for Melting Purposes" issued November 3, 1936, and assigned to the Los Angeles By-Products Company.

The Gregg patent discloses a method for preparing "a clean high-grade scrap iron" (A. 7a, page 1, column 1, lines 35-36; R.339) from "old discarded automobile bodies" (page 1, column 2, line 6), among other scrap metal, for use in the manufacture of steel. The process described in the Gregg patent includes, *inter alia*, the steps of a) shredding or fragmentizing automobile scrap in a hammer-mill, b) magnetically separating the ferrous fragments from the nonferrous material, and c) either discharging the ferrous fragments "into a suitable storage bin" (page 2, column 2, lines 1 and 2) or delivering them to a hopper and compacting them in a baling press.

Scrap processors were also familiar with the use of rolls for compacting ferrous scrap. Sam Proler, the patentee and president of appellant, testified that he was familiar with rolls and their function prior to making the invention, and he described how his company had used rolls commercially prior to 1956 for compacting scrap cans prior to shredding in a hammermill and then magnetically separating the ferrous from the nonferrous material (Proler dep. pp. 173-175; R. 542; appellant's brief pp. 21-22).

D. The Accused Process

There is no material issue of fact raised by appellant in regard to the accused process.

The commercial operation of appellees' plant in Vernon, California, began in September 1963. At first the process included the steps of shredding or fragmentizing raw ferrous scrap in a hammermill, magnetically separating the ferrous fragments from the nonferrous material, and then

separating the larger pieces from the smaller pieces to produce a higher density product and a lower density product. After a few weeks appellees eliminated the step of separating the larger and smaller fragments and produced a single fragmentized scrap product (R. 266-267).

Appellees' process did not and never has included a roasting step.

Appellant has not charged that the process practiced by the appellee prior to May 1965 infringes the Proler reissue patent (R. 56). Appellant claims that the appellees' process as practiced from May 1965 infringes the process of claim 9 of the Proler reissue patent.

The chart (A. 3a; R. 340) illustrates schematically and compares the Proler process as set forth in claim 9, appellees' process prior to April 1965 and appellees' accused process from May 1965.

During the period prior to May 1965 appellees were in regular commercial production and sold their fragmentized scrap, Lurmet, but they were also constantly experimenting with modifications in apparatus and procedures with the object of minimizing costs. One cost problem in all hammermill operations, whatever their use may be, is the tremendous wear within the hammermill on the shredding hammers, the grates and the breaker plates, as well as other parts. In fragmentizing or shredding scrap iron these wear problems are particularly serious (A. 8a; R. 343).

During the operation prior to May 1965 one area of experimentation by appellees was with grate openings of different sizes. The grate is essentially a massive screen at the bottom of the hammermill through which scrap fragments are discharged after fragmentization. The grate, for example, is identified in the drawings of the Proler reissue patent by the reference numeral 12 (A. 5a; R. 335). Appellees' experiments confirmed that the density of Lurmet could be controlled by the size of the grate openings—the density increasing with grates having smaller openings and decreasing with grates having larger openings. Appellees also found, as would be expected, that overall wear in the hammermill increased with the smaller grate openings and decreased with the larger openings (A. 9a; R. 343).

In April 1965 appellees installed in their hammermill a grate having comparatively larger openings and simultaneously began separating the larger fragments from the product and recycling these through the same hammermill for further fragmentizing and subdivision. As a result of this change appellees confirmed that they were able to improve the efficiency of the hammermill in the production of Lurmet while maintaining the density of the product in the desired range. The tendency to over-reduce the size of some of the fragments in the hammermill when equipped with smaller grate openings was eliminated and wear, breakage and down time were minimized (A. 9a; R. 343).

Appellant's position on infringement must be that the operation of the hammermill on the recycled pieces is the same as or the equivalent of the function of the rolls in

the Proler process, namely, the function of "individually compacting and balling up the pieces of the more ferrous bearing shredded material to densify it while maintaining the individuality of the separate pieces."

Appellees do not deny that there may be some compacting of the malleable pieces of scrap in the hammermill during both the first pass and on recycling. The action of hammers on the malleable material being shredded may produce some crumpling and compacting effect. Appellees, however, have shown by uncontroverted tests that their hammermill, as would be expected, further fragmentizes and subdivides the pieces of ferrous scrap recycled therein, thereby destroying the individuality of the separate pieces (A. 10a; R. 345; Burlingame dep. of June 1, 1966, pp. 12, 13 and 37). This operation is in contrast to the function of the rolls in the Proler reissue patent which compact the pieces of ferrous material to increase its density "while maintaining the individuality of the separate pieces."

II. NO CONTROLLING ISSUE OF FACT

The Court below granted summary judgment to appellees on each of the following grounds:

1. Claim 9 of the Proler reissue patent is invalid because it recites nothing more than the known functions of old apparatus;
2. Appellees' accused process does not infringe claim 9 of the Proler reissue patent;

3. Claim 9 of the Proler reissue patent is invalid because the invention claimed therein is not the invention disclosed in the original patent;

4. Claim 9 of the Proler reissue patent is invalid because the defect of the original Proler patent did not arise through error; and

5. Claim 9 of the Proler reissue patent is invalid because the record, including the oath, fails to show any error.

The questions on appeal are 1) whether appellant has shown that the Court below resolved any issue of material fact or failed to consider any material fact in granting the summary judgment, and 2) whether summary judgment was properly granted on the basis of the undisputed facts.

Appellant has not raised any controlling issue of fact either in opposition to the motion for summary judgment or in the brief on appeal. The controlling facts are either conceded by appellant or are irrefutable on the basis of the record.

The material facts on which appellees have relied were submitted with their motion for summary judgment as required by Rule 3(g) 1. (A. 37a) of the Rules of the United States District Court for the Central District of California (1967). The material facts were all supported by depositions of the parties, particularly of Sam Proler, the patentee, and appellant's answers to interrogatories, supplemented by the Derlacki and Hassialis affidavits (A. 8a, 10a; R. 342, 345).

Appellant responded both in the Court below and in its brief on appeal by mere allegations that genuine issues

exist without detailing any specific fact issue that would be controlling on the motion for summary judgment, by objections to the form or materiality of the undisputed facts, and by setting forth issues which are either irrelevant to the grounds on which summary judgment was granted or are framed in such broad and general terms that they fail to bring into issue any of the specific material facts relied on by appellees and adopted by the Court below.

Appellant has not set forth by affidavit or otherwise any specific fact showing that there is a genuine issue for trial as required by Rule 56(e) FRCP (A. 36a). Moreover, appellant has not shown the existence of any controlling fact which if resolved favorably to it would have barred summary judgment for appellees.

Rule 3(g)3. of the local rules of the Court below states:

“3. In determining any motion for summary judgment, the Court may assume that the facts as claimed by the moving party are admitted to exist without controversy except as and to the extent that such facts are controverted by affidavit filed in opposition to the motion” (A. 37a).

Appellant has not controverted the material facts relied on by appellees by affidavit. These facts, therefore, may be deemed admitted by appellant.

A careful analysis of appellant's position shows that the real controversy between the parties is not with regard to the material facts relied on by the Court in granting summary judgment but to the legal conclusions made by the Court on the basis of the undisputed facts.

The Court's FF 1.1, 1.2, 1.3, 1.4, 2.1, 2.3, 2.4, 2.6, 3.1, 3.2, 4.1, 4.2, 4.5 and 4.6 are not disputed.

Although disputed, FF 3.3 and 3.5 are admitted in appellant's brief (page 12 and pages 21, 22 and 29, respectively).

FF 3.6 is not disputed, but it is alleged that Proler was testifying about tamping, not the function of rolls. The objection ignores the fact that Proler was equating tamping and the function of rolls, and that these functions are equated in appellant's brief (page 53).

Appellant disputes FF 4.3 on the basis that all Lurmet produced by appellees before and after May 1965 was not of the same density. The finding does not state that the densities were at all times identical but only that they were in the same range. The finding is accurate, consistent with the record and supported by the Derlacki affidavit (A. 8a; R. 343).

Appellant objects to FF 4.4 on the ground that it misstates the charge of infringement. As a matter of law, 35 U.S.C. §112 (A. 34a) requires that the compacting step of claim 9 be interpreted to cover the function of rolls or their equivalent. As a matter of law, unless the function of appellees' hammermill on recycled scrap is the same as or the equivalent of the function of the compacting rolls in appellant's patented process, appellees' process cannot be held to infringe claim 9.

Appellant disputes FF 4.7 because it states that the function of appellees' hammermill is to shred and sub-

divide the pieces of scrap, thereby destroying the individuality of the pieces. The statement is supported by the uncontroverted Hassialis affidavit (A 10a; R. 345; see also Burlingame dep. of June 1, 1966, p. 37). Moreover, the function of the hammermill in the Proler reissue patent is to shred and subdivide the pieces of scrap, so that it is not surprising that appellees' hammermill functions in the same manner.

The correctness of the remaining findings which are disputed, i.e., FF 2.2, 2.5, 2.7, 3.4, 3.7 and 4.8, can be verified by reference to the Proler reissue patent (A. 5a; R. 335), the history of its prosecution (R. 360-517), and the disclosure of the Gregg patent (A. 7a; R. 339).

Appellees do not endorse as accurate all of the contentions set forth in appellant's brief. Appellant in its brief makes many self-serving contentions which the Court below recognized are not controlling on the propriety of the summary judgment even if resolved favorably to appellant.

The Court below correctly concluded that the posture of this case at the time of adjudication showed that there was no need to take testimony upon the questions of validity and infringement. The controlling facts were of record and were not at issue. Appellant had not raised any specific fact controlling on summary judgment and with respect to which there was an issue. The papers submitted to the Court below established that on the issues of validity and infringement the problem is essentially one of applying legal standards to the uncontroverted controlling facts before it.

This case comes squarely within the prerequisite for summary judgment set forth in Rule 56(c) FRCP:

“The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law” (A. 36a).

III. SUMMARY OF THE ARGUMENT

Appellant has not challenged any controlling fact on which appellees have relied in support of their motion for summary judgment. Appellant's challenge to the summary judgment is to the legal conclusions which the Court has reached on the basis of these facts.

A. Aggregation

The parties are in agreement that 1) the first two steps of the claim 9 process, namely, fragmentizing raw ferrous scrap in a hammermill and then magnetically separating the ferrous pieces from the nonferrous material are old (R. 38, 39, 385); 2) that compacting rolls are old and that ferrous scrap cans have been compacted between rolls prior to the steps of shredding the cans in a hammermill and then magnetically separating the ferrous from the nonferrous material (Proler dep. pp. 173-175; R. 542; appellant's brief, pp. 21-22); and 3) that the third step of the Proler process can be carried out using rolls that were conventional prior to the alleged invention (R.49). The dispute between the parties is whether on the basis of

these facts the Court properly concluded that claim 9 is invalid.

Although admitting that the first two steps of the claim 9 process are old, appellant argues that appellees have not shown that the third step is old. Surely appellant cannot assert that Sam Proler was the first ever to compact a piece of malleable ferrous scrap. Appellant must argue that the third step of the process is novel because it has never been practiced *seriatim* following the two admittedly old steps.

The process of claim 9 is invalid as an obvious aggregation of steps old in the art, irrespective of whether or not the compacting step has ever before been practiced *seriatim* with the first two steps by the same person in the same process. The doctrine of aggregation applies to a new combination of old steps when the steps fail to cooperate to produce anything more than an obvious or expected result.

The compacting step of claim 9 is nothing more than the usual function of conventional rolls. Since rolls and their compacting function on malleable material are well known and a matter of common knowledge, not only to scrap processors but to laymen as well, it is clear that to combine the ordinary compacting function of rolls with two admittedly old steps is obvious under 35 U.S.C. §103 (A. 34a) and fails as a matter of law to meet the "severe test" of *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U. S. 147 (1950) (hereinafter referred to as the *A & P* case) and the many other cases pertaining to the law on aggregation.

B. Noninfringement

On the issue of noninfringement appellant is riding on the horns of a dilemma. After conceding that the processing of ferrous scrap in a hammermill is old, appellant, to establish infringement under 35 U.S.C. §112 (A. 34a), must rely on this step as the equivalent of the compacting step performed by the conventional rolls disclosed in the Proler reissue patent.

Appellees do not use rolls to compact the malleable pieces of fragmentized scrap as in the Proler process, but appellant charges that the recycling of only the larger pieces of fragmentized scrap through the same hammermill performs the compacting function of conventional rolls. Appellant's argument conveniently emphasizes the fragmentizing function of the hammermill and ignores the compacting function on scrap which passes but once through the hammermill, and emphasizes the compacting function and ignores the fragmentizing function on the recycled scrap which passes simultaneously through the same hammermill.

If a crumpling and mashing function of the hammermill accompanies the fragmentizing operation and if it is the same as or equivalent to the third step of claim 9, which purports to be the function of ordinary rolls, then surely it follows that this step is old because appellant has conceded that it is old to process ferrous scrap in a hammermill. If the step is old, then claim 9 must be held both invalid and not infringed by appellees' process.

But the third step of claim 9 specifies that the compacting action is carried out "while maintaining the individ-

uality of the separate pieces'' of ferrous scrap, language which is descriptive of the compacting function of rolls but not of the fragmentizing or subdividing function of a hammermill. Moreover, it is evident on the face of the Proler reissue patent and from the testimony of Sam Proler, the patentee, that the functions of hammermills and rolls are clearly not equivalent. On these facts the Court below concluded as a matter of law that appellees' process did not infringe claim 9 of the Proler reissue patent.

C. Defective Reissue

Appellees rely on the histories of the prosecution of the abandoned Proler application, the original Proler patent and the Proler reissue patent as support for their position that the roasting step was described and emphasized as an essential step of the process prior to the application for the Proler reissue patent.

The Court below was certainly far more competent than a jury* to examine the record of these Patent Office proceedings and determine whether, within the meaning of the reissue statute 35 U.S.C. §251 (A. 34a), claim 9 is for the same invention disclosed in the original Proler patent as that provision has been interpreted in the case of *U.S. Chemicals Co. v. Carbide*, 315 U.S. 668 (1942) (hereinafter referred to as the *U.S. Chemicals* case).** The Court properly concluded that in omitting the essential roasting step claim 9 is not directed to the invention disclosed in and intended to be covered in the original Proler patent.

* Appellant had demanded a jury trial.

** " * * * it is the duty of a court to determine for itself, by examination of the original and the reissue, whether they are for the same invention." *U. S. Chemicals* case, p. 678.

Similarly, the Court was competent to determine whether on the basis of the record there was "error" within the meaning of the reissue statute, and to pass on the legal effect of the reissue oath. The Court below properly determined that there was no error and that the reissue oath was defective on the basis of that record.

IV. ARGUMENT

A. Claim 9 of the Proler Reissue Patent Is Invalid for Claiming a Mere Aggregation of Steps Old in the Art

1. Claim 9 Is a Classic Example of Aggregation

Claim 9 of the Proler reissue patent merely strings together an aggregation of old steps, namely, the shredding function of a conventional hammermill, the separating function of a conventional magnetic separator, and the compacting function of conventional rolls.

This is not in dispute. Appellant concedes it, as shown by appellant's responses to appellees' interrogatories 10 B, D and E (R. 48, 49) which are as follows:

"B. Could the process of the patent in suit be practiced using as the hammermill 11 one that was conventional at the time of the alleged invention by the patentee?

Response

Yes.

"D. Could the process of the patent in suit be practiced using as the magnetic separator 16 one that was conventional at the time of the alleged invention by the patentee?

Response

Yes.

“E. Could the process of the patent in suit be practiced using as the rolling mill 19 one that was conventional at the time of the alleged invention by the patentee?

Response

Yes.”

The ordinary functions of hammermills, magnetic separators and rolls on ferrous scrap have long been known and used in the processing of ferrous scrap before April 1957, the alleged date of conception of the process of the Proler reissue patent.

The steps of shredding or fragmentizing raw automobile scrap in a hammermill and then magnetically separating the ferrous fragments from the nonferrous material are steps which have been practiced by the Los Angeles By-Products Company during the 1930s and '40s (R. 54; appellant's brief p. 12). The Los Angeles By-Products Company produced a clean, fluent, fragmentized scrap before subjecting it to a baling operation.

The steps of fragmentizing scrap in a hammermill and then magnetically separating the ferrous pieces from the nonferrous material are also described in the prior art Gregg patent (A. 7a; R. 339). The clean, fluent, fragmentized scrap was described as either stored in a bin or compacted by a baling operation.

The third step of the Proler process, namely, the compacting of the individual pieces, is also old. Appellant's position is that this step can be carried out not only by a set of conventional compacting rolls but also by tamping (appellant's brief p. 53). It is a matter of record that

scrap processors, including appellant, were familiar with the use of rolls in compacting malleable ferrous scrap prior to the Proler process. Sam Proler, the patentee and president of appellant, had no hesitation in admitting that he was familiar with rolls and their function prior to making his invention, and in his deposition described the rolls used commercially by appellant prior to 1956 for compacting scrap cans by flattening prior to shredding in a hammermill and then magnetically separating the ferrous from the nonferrous fragments (Proler deposition pages 173-175; R. 542; appellant's brief pp. 21-22).

The compacting and balling up function of the rolls 19, as recited in the third step of claim 9 of the Proler reissue patent, is the ordinary flattening and compressing function of conventional rolls. Proler so testified at page 191 of his deposition:

“Q. So flattening, in your mind, is the same as balling up; is that right? A. If it increases the density by decreasing the size of the piece.

Balling up may not be making it perfectly flat, but making it smaller in size, the piece itself, than it was, before you did anything to it.”

The first two steps of fragmentizing in a hammermill and then magnetically separating the ferrous pieces from the nonferrous material are admittedly old (R. 38, 39, 385). The third step of passing the ferrous pieces through conventional compacting rolls produces no new, unusual or surprising result. The result is compaction, the age-old function of rolls.

It has long been recognized that the mere combination of old elements or steps which perform or produce in the

combination no new or different function or operation than that heretofore performed or produced by them individually is a mere aggregation of old elements and not a patentable invention. Claims reciting a mere aggregation of old steps or elements are invalid as a matter of law.*

The improbability of finding invention in a combination of old elements is stated in the *A & P* case at 152-153:

“Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly.”

For a combination of old steps or elements to be held patentable the combination must produce in some way or manner a surprising or unusual result which would not

* In the *A & P* case Mr. Justice Douglas stated in his concurring opinion at page 155:

“The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law.”

See also *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F.2d 801, 803 (9th Cir. 1957, rehearing denied 1958); *Bentley v. Sunset House Dist. Corp.*, 359 F.2d 140, 144 (9th Cir. 1966).

have been expected by a person having ordinary skill in the art, and these elements or steps must perform an additional and different function in the combination than they performed out of it. *Lincoln Engineering Company of Illinois v. Stewart-Warner Corp.*, 303 U. S. 545, 549; *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *A & P* case, pages 151-152.

Stated another way, “* * * only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable.” *A & P* case, page 152.

This test, labeled “severe” by the Supreme Court in the *A & P* case (page 152), has been consistently applied in this circuit. *Bentley v. Sunset House Dist. Corp.*, 359 F.2d 140, 144 (9th Cir. 1966). The “severe test” has been characterized as more exacting than the condition of 35 U.S.C. §103 that patentable subject matter must be unobvious at the time the invention was made to a person of ordinary skill in the art. *Santa Anita Manufacturing Corp. v. Lugash*, 369 F.2d 964, 967 (9th Cir. 1966).

Applying the principle of the *A & P* case to the facts herein, it is clear that the process of claim 9 of the Proler reissue patent fails to meet the test of invention. None of the three old functions of conventional equipment performs any new or different function in the combination than it performs out of it.

“Two and two have been added together and still they make only four.” *A & P* case, page 152.

2. The Compacting Step Is Old and Both the Compacting Step and the Result Thereof Are Obvious

Appellant argues that the third step of claim 9 is novel and that the process of claim 9 produces a "new, useful, and unexpected result" in the form of a "revolutionary" product.

The Court should understand that appellees' fragmentized scrap product does not and is not charged to infringe the Proler reissue patent. Claim 9, the only claim in issue, is a process claim.

Appellees' fragmentized scrap, Lurmet, is in the public domain.* Sam Proler did not invent fragmentized ferrous scrap. Fragmentized ferrous scrap was produced by the Los Angeles By-Products Company in the 1930s and 1940s and by the process of the prior art Gregg patent before it was subsequently compacted into a bale or stored in a bin. Furthermore, appellees' fragmentized scrap, Lurmet, has been produced by the appellees from September 1963 until May 1965 by a process which appellant concedes did not infringe the Proler reissue patent.

Appellant argues that the third step of the process of claim 9 is new because there is no evidence that individual pieces of malleable scrap have ever been compacted prior to the Proler process.

* Appellant can argue that its product, Prolerized scrap, is covered by claim 2 of the Proler reissue patent. Claim 2 covers a product made by the process of claim 1, that is to say, a product made by the steps of shredding, magnetically separating, roasting and compacting. Appellees are not charged with infringing claim 2 because they do not use the roasting step.

Even accepting, *arguendo*, appellant's position that the compacting step as set forth in claim 9 had not been previously performed, Proler's contribution to known processes for handling scrap was nothing more than to propose feeding scrap which had been previously fragmented and magnetically separated from nonferrous material through conventional rolls for the purpose of compacting the more malleable pieces to increase the density. That the rolls did indeed compact the malleable pieces of scrap and increase the bulk density is an obvious result and hardly one which is unexpected.*

The conclusion that the compacting function of rolls is old and obvious is one that any layman would necessarily reach with knowledge that the step could be carried out by rolls which were conventional and used by scrap processors prior to the Proler process for compacting ferrous scrap cans. The compacting step is not one upon which appellant can rely to sustain the validity of claim 9 because it clearly cannot meet the statutory test of unobviousness. 35 U.S.C. §103 (A. 34a); *Graham v. John Deere*, 383 U. S. 1 (1966).

Appellees do not have to show that rolls have been used to compact fragments of magnetically separated ferrous scrap in order to support their contention that claim 9 is invalid as an aggregation of steps old in the art. That is to say, appellees do not have to establish a complete antic-

* A housewife who has used a wringer for squeezing water from washed clothes or a rolling pin for flattening dough would expect malleable ferrous fragments to be compacted in passing between rolls.

ipation of the process of claim 9 pursuant to 35 U.S.C. §102.

On the contrary, under the test of the *A & P* case and pursuant to 35 U.S.C. §103 (A. 34a) appellees need show only that the compacting of malleable material was old or obvious prior to the Proler process, not that it was necessarily used *seriatim* with the first two steps. In most of the cases where courts have held patents invalid on the basis of aggregation the patentee admittedly has been the first to combine all of the old elements or steps.

In *Hunter Douglas Corp. v. Lando Products*, 215 F.2d 372 (9th Cir. 1954), the patent in suit was for a process of trimming the edges of aluminum strips used in Venetian blinds by a series of shaving and rolling steps. Judge Lemmon, quoting from *Kwikset Locks v. Hillgren*, 210 F.2d 483 (9th Cir. 1954), held the patent in suit invalid (p. 375):

“ ‘In the circumstances where a patent is sought on a combination of devices or processes known to the prior art, the concept of invention remains elusive. It has been said that, in order for the combination to be considered a patentable invention it must “perform some new or different function—one that has unusual or surprising consequences.” * * * There is no invention in a “mere *aggregation* of a number of old parts or elements”, nor in the *accumulation* of old devices which do not in some way exceed “the sum of its parts.” * * * Moreover, a truly inventive combination must create what had not before existed or bring to light what lay hidden from vision in a way which can be distinguished from “simple mechanical skill.” A mere advance in efficiency and utility is not enough to con-

vert a non-inventive aggregation into a patentable combination'."

* * *

"The rolling operation in the Hunter invention is to thin the strip. That is true of all rolling operations. The shaver is designed to trim the edges. Likewise, that is true of all shavers. Passing the strips through a number of rolls was known. No new or different function is disclosed.'" (Court's emphasis)

Appellees submit that on the basis of facts admitted by appellant the step of compacting malleable fragments of scrap between rolls is both old and obvious and the result produced thereby is precisely what anyone, whether skilled in the art or not, would expect.

B. Appellees' Accused Process Does Not Infringe Claim 9 of the Proler Reissue Patent

The commercial operation of appellees' plant which began in September 1963 and continued until April 1965 involved the shredding or fragmentizing of raw ferrous scrap in a hammermill followed by magnetic separation of the ferrous fragments from the nonferrous fragments to produce ferrous scrap fragments. Appellant concedes that this process practiced by the appellees prior to May 1965 did not infringe the Proler patent (R. 56).

Appellant contends that appellees' process using the same hammermill to further fragmentize recycled larger pieces as practiced subsequent to April 1965 infringed the process of claim 9 of the Proler reissue patent.

The alleged infringement of process claim 9 must be resolved on the basis of a comparison of the process steps thereof with the accused process and not on the basis of a comparison of the products. In *United States Rubber Co. v. General Tire & Rubber Co.*, 128 F.2d 104, 109 (6th Cir. 1942), the Court stated:

“Infringement of a process claim is not established merely by showing that the defendant has accomplished the same result, if he has followed substantially different procedure. The test is whether he has, in all substantial aspects, followed the method claimed.”

The same rule was stated in *Allen v. Standard Crankshaft & Hydraulic Company*, 210 F.Supp. 844, 850 (W.D. N.C. 1962), affirmed 323 F.2d 29 (4th Cir. 1963), as follows:

“Even if the defendants’ process produces the same result, that alone does not constitute infringement. In order to infringe, defendants’ process must operate in the same mode or manner.”

Claim 9 defines “a process of refining a raw ferrous bearing scrap material * * * whereby a fluent mass is obtained” comprising three steps:

step 1—“shredding the raw material”;

step 2—“separating the more ferrous bearing shredded material”; and

step 3—“individually compacting and balling up the pieces of the more ferrous bearing shredded material to densify it while maintaining the individuality of the separate pieces”.

Appellees concede that they practice steps 1 and 2. Appellant concedes that steps 1 and 2 are old (R. 38, 39, 385).

As to step 3, appellant contends that in appellees' process the hammermill acts on the recycled fragments in the same way that the compacting rolls act in the Proler process, i.e., the hammermill acts on the recycled fragments by "individually compacting and balling up the pieces * * * while maintaining the individuality of the separate pieces."

Appellant's contention on its face is without substance. Appellees do not use rolls or any equivalent thereof and thus do not employ step 3 in their process.

The language of claim 9 stating that the "compacting and balling up of the pieces" are carried out "while maintaining the individuality of the separate pieces" is functional and must be interpreted in accordance with the statutory provision of 35 U.S.C. §112 (A. 34a). The third paragraph of Section 112 provides:

"An element in a claim for a combination may be expressed as a means or a step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

See *Stearns v. Tinker & Rasor*, 252 F.2d 589, 597 (CA 9, 1957).

Since rolls are the only means described in the Proler reissue patent for carrying out the step of compacting and balling up while maintaining the individuality of the separate pieces, the third step of claim 9 must be interpreted as limited to the function of rolls or their equivalent.

The Court below recognized that on the basis of the undisputed facts in this case the fragmentizing operation of appellees' hammermill could not be found to be the equivalent of the third step of claim 9 of the Proler re-issue patent. They are not equivalent because (1) the words "compacting and balling up the pieces * * * while maintaining the individuality of the separate pieces" are not descriptive of the function of a hammermill, and (2) the nonequivalence of the functions of rolls and hammermills has been recognized both in the Proler reissue patent and by the patentee, Sam Proler.

In the operation of a hammermill the ferrous scrap is fragmentized, and in the operation of rolls the ferrous scrap is compacted while maintaining the individuality of the separate pieces. Appellees rely on the undisputed fact that the step of fragmentizing scrap in a hammermill is old, on the undisputed fact that the recycled fragments are further fragmentized in appellees' hammermill, and on the irrefutable fact that the functions of hammermills and rolls are not equivalent. Appellant's argument that the hammermill also compacts, albeit without maintaining the individuality of the separate pieces, is immaterial to appellees' grounds for asserting noninfringement.

In the operation of a hammermill the ferrous scrap is fragmentized as it passes between a breaker plate and the rotating hammers. Some of the scrap fragments immediately pass through the openings in the grate. Other scrap fragments move around within the hammermill as the hammers rotate and are further fragmentized during internal recycling.

In his deposition Sam Proler described the shredding or fragmentizing operation of a hammermill on the material cycled once and on the material internally recycled therein. Proler testified that the ferrous scrap cycled once through a hammermill is shredded:

“The first time you put it through, you put in a whole car or a stove or a refrigerator and it shreds it up into small pieces.” (Proler dep., p. 25, line 24, p. 26, line 2)

He then describes the further shredding of the internally recycled scrap as follows:

“Actually, it shreds the material up. There are big pieces such as automobiles, stoves, refrigerators, ice boxes, and the hammers rip through and tear and shred the big pieces up and throw them around, and if they are small enough to go through the grate, they go through the grate opening size, and if they are bigger, they go around, and it shreds them and it tears them up again, and they come out shredded and in smaller pieces and fall through the openings.” (p. 43, lines 5-13)

In contrast, in the operation of rolls the ferrous scrap is compacted while maintaining the individuality of the separate pieces. Proler, in his deposition on page 72, lines 3 through 10, described the operation as follows:

“Q. Is there any subdividing of the material in the operation of these rolls? A. What do you mean subdividing?

“Q. I think you call it shredding. Is it broken up into smaller pieces? A. No, it is individually compacted, squeezed together, balled up and condensed into smaller pieces—*the pieces that go in are the pieces that come out.*” (Emphasis ours)

Not only is the language "compacting and balling up the pieces * * * while maintaining the individuality of the separate pieces" inappropriate for describing the function of a hammermill, but the nonequivalence of the functions of the two pieces of equipment is recognized both in the patent and by Sam Proler, the patentee.

The Proler reissue patent clearly differentiates between the functions of the hammermill and the rolls. The hammermill is described as a "reducing means 11" and the operation thereof is described as follows:

"There the sheet metal is largely cut and shredded and the other material is cut and shredded and broken until the material is small enough to pass through the openings in the grate 12." (A. 5a, column 2, lines 11-15; R. 338)

The operation of the rolls 19, in contrast, is described in the Proler reissue patent, and particularly in claim 9, as that of individually compacting and balling up the pieces while maintaining the individuality of the separate pieces. In the Proler reissue patent the express functions of the hammermills and the rolls are to perform different and essential steps of the process. It is completely illogical to suggest that the different functions to accomplish different steps of the process are equivalent.

Sam Proler emphasized the different functions of a hammermill and rolls in the proceedings before the Patent Office when he was distinguishing his process from the earlier process used by the Los Angeles By-Products Company and described in the Gregg patent. Proler charac-

terized the function of the hammermill as "size reduction" and the function of the rolls as "rolling". Proler stated:

"Applicant will admit that size reduction and magnetic separation are old steps, e.g. as shown in the cited supplemental German reference, or in the Gregg patent (*supra*), but there is no suggestion of a combination of such steps with the steps of roasting the resultant material and then rolling the roasted scrap." (R. 385)

Although admitting that the process of fragmentizing ferrous scrap in a hammermill and then magnetically separating the ferrous fragments from the nonferrous material as practiced from 1963 through April 1965 does not infringe the Proler reissue patent, appellant claims that when the larger pieces of ferrous scrap are separated out from the product and recycled through the same hammermill, the function of the hammermill on the recycled pieces then becomes the equivalent of the compacting rolls.

The operation of the hammermill on all ferrous material passing through it, whether raw or recycled scrap, is necessarily the same. How can a continuously operating hammermill perform on scrap fragments a noninfringing and an infringing operation simultaneously? There is only one answer. It can't, and appellant's contention of infringement must fail. There is just no way for a hammermill with forty steel hammers each weighing 190 lbs. (a total weight of 7600 lbs.), revolving 700 times a minute (i.e., traveling at 150 m.p.h.) in a steel cage to be selective in its treatment of unrecycled material, internally recycled material and recycled material (Schroder dep. pp. 47, 53-70).

The tests performed by Prof. Hassialis (A. 10a; R. 345) establishing that the recycled material is shredded and subdivided in appellees' hammermill more than fivefold, that is to say, more than five times as many pieces are made for each piece recycled, are not challenged by appellant.

Sam Proler does not even dispute the fact that the recycled material is further fragmentized in the hammermill. When examined with regard to what happens with respect to the recycled fragments as compared with those fragments which he said "go around" within the hammermill, that is, internally recycled, he testified as follows:

"Q. I thought you had originally testified that some of the material originally put in and shredded continued around several cycles, around the rotor before it came out. A. That is what I say, it shreds and comes out in small pieces.

"Q. Even though a smaller piece? A. Even though a smaller piece, it is shredded, comes out in small various-sized pieces, smaller than the openings of the grate.

"Q. Why isn't the recycle material shredded too as it goes back in for recycling? A. It is, and that is the reason we are here.

"Q. Right. But I don't see how you distinguish between the two. A. Well, they recycle the material that is larger and heavier, although it came through the grate openings, to recycle back through the mill to reduce the size and increase the weight." (p. 203, line 13 through p. 204, line 7)

On the basis of the functional language of the third step of claim 9 and the uncontroverted facts and admissions made by appellant, it is clear that the appellees' accused process does not include the function performed on the

pieces of ferrous scrap by the rolls in the Proler process, or any equivalent of that function. The only possible conclusion is that the accused process does not infringe claim 9 of the Proler reissue patent.

Appellant's brief does not contradict or challenge the affidavit of Prof. Hassialis, but it states incorrectly that the Hassialis affidavit failed to advise the Court whether the pieces counted by him were merely small chips knocked off the larger fragments. The Hassialis affidavit states clearly that he counted only "plus $\frac{1}{2}$ inch pieces" (A. 12a, 13a; R. 348, 349) and that the ratio of subdivision would have been much higher if pieces $\frac{1}{2}$ inch or smaller had been counted.

Again, appellant does not contradict or challenge the statement in the Hassialis affidavit that recycling is a standard and recognized technique, known as "closed circuit operation", for operating a hammermill efficiently. Appellant relies on the Pennington affidavit which merely points out that the texts referred to by Prof. Hassialis deal with the recycling of rock and brittle material and not with shredded sheet steel. The Pennington affidavit, however, does not deny that the underlying theory for the increase in efficiency applies equally to a closed circuit operation of a hammermill regardless of whether it is fragmentizing rock or ferrous shredded scrap.

Appellant also overlooks the fact that the Proler reissue patent itself refers to the fragmentizing of rock as relevant to the art of size reduction at column 1, lines 31-34, in the statement:

“A further object of the invention is to produce a flowable material, analogous to graded hard coal or rock * * *”

If appellant set out to achieve an analogous product it must follow that analogous prior art procedures should be recognized as relevant.

Appellant tries to bridge the gap between the functions of hammermills and rolling mills by irrelevant references to a “nuggetizer”, a hammermill specially designed by the Williams Patent Crusher & Pulverizer Company to “nuggetize” ferrous pieces. The “nuggetizer” is a special type of apparatus and the subject of the Williams patent No. 3,283,698 (appellant’s Ex. P). It is undisputed that appellees do not use and have never used a “nuggetizer” in the accused process (Williams dep. of June 21, 1967, p. 49, Burlingame dep. of June 1, 1966, pp. 12, 13 and 37). On the contrary, the uncontroverted Hassialis affidavit establishes that appellees’ hammermill fragmentizes the recycled pieces and operates in the manner of conventional hammermills.

In its brief appellant has made reference to an affidavit of Derlacki filed in the 1963-64 Texas case stating that appellees had no plans “to recycle any of its product or to compact the individual particles of the product in the foreseeable future” and argues that in a year’s time appellees “were obviously forced to add the third step”—recycling. There are no facts in dispute and no adverse inferences to be drawn from the facts. In 1963 Derlacki’s deposition was taken by Proler in the Texas case and he testified as follows:

“Q. —there are no plans for compacting the lighter material?” A. That is right.

“Q. What do you mean by that answer? A. I mean by that that we have no plans for doing anything but putting it into a shipping container right now.

“In the future, if we feel it desirable to get a greater effective density from this material, we do not plan to compact it, or to press it together. We have the option, if we so desire, of taking that material and putting it back through our whole process again, placing it on the main feed conveyor.

“Q. Reshredding it? A. Reshredding it, right.”
(Derlacki dep., 1963, p. 73)

This is a clear statement that at the time, 1963, appellees did not intend to compact but that they had the option of putting material “back through the whole process again” by “placing it on the main feed conveyor” to reshred it. The Derlacki affidavit filed in 1964 merely reaffirmed this position.

The record is clear that there was an experimental period during 1963, 1964 and into 1965 in which the effect on density and overall wear of the grate bar openings, large and small, was investigated (A. 8a; R. 343; dep. R. Ablon pp. 72, 75-79, 81; dep. C. Ablon pp. 39-44). Burlingame called it a “learning” period (Burlingame dep. of June 1, 1966, p. 21). As a result of these experiments, appellees decided to use larger grate openings to minimize hammer-mill wear and overgrinding and to separate and recycle the larger fragments to maintain the density of the product (A. 9a; R. 343; Magness dep. of Oct. 29, 1965, pp. 49-50). This course of events is not inconsistent with Derlacki’s testimony and affidavit in the earlier Texas litigation.

Appellant implies that appellees were forced to recycle to obtain a product of high enough density. The Proler reissue patent states the product produced thereby "will have a density of at least 50 pounds per cubic foot and usually more in the vicinity of 60 pounds per cubic foot or even higher" (A. 5a, column 3, lines 27-29; R. 338). It is a matter of record and not disputed that appellees produced a product of up to 80 pounds per cubic foot prior to May 1965 without recycling (Derlacki dep. of Oct. 29, 1965, p. 100), and that its customer preferred a product of about 70 pounds per cubic foot (Burlingame dep. of Oct. 30, 1965, pp. 17, 68, 95). The argument, however, is irrelevant and diversionary because the controlling fact on noninfringement is that in appellees' process the larger pieces of fragmentized scrap which are recycled through the hammermill are further fragmentized and subdivided, as established by the Hassialis affidavit (A. 10a; R. 345). Appellant cannot and has not denied this fact by questioning appellees' motive for recycling.

There being no dispute as to the controlling evidentiary facts, the Court, comprehending the nature of the patented process and the alleged infringing process on the basis of the record and exhibits, properly determined that the accused process did not infringe claim 9 of the Proler reissue patent as a matter of law. *Kwikset Locks v. Hillgren*, 210 F.2d 483 (9th Cir. 1954), cert. denied, 347 U. S. 989 (1954) and cases cited, *infra*, pp. 53, 54.

Appellees have advanced the arguments that (1) shredding of the recycled fragments in a hammermill does not occur "while maintaining the individuality of the separate pieces" as is essential to claim 9 of the Proler reissue

patent; (2) shredding in a hammermill is not the equivalent of the compacting function of rolls; and (3) the use of a device known to the prior art (a hammermill) in a manner known to the prior art, i.e., to treat recycled fragments and to simultaneously treat the unrecycled fragments, cannot infringe claim 9 of the Proler reissue patent.

Summary judgment of noninfringement is justified on each of these grounds.

C. Claim 9 of the Proler Reissue Patent Is Invalid Because the Invention Claimed Therein Is Not the Invention Disclosed in the Original Proler Patent

1. The Applicable Law

The reissue of inoperative or invalid patents is authorized pursuant to 35 U.S.C. §251 (A. 34a) which reads in part:

“* * * the Commissioner shall * * * reissue the patent for the *invention disclosed in the original patent* * * * No new matter shall be introduced into the application for reissue.” (Emphasis ours)

The requirement that the reissue must be for the same invention as the invention described in the original patent has long been recognized. In *Parker and Whipple Co. v. Yale Clock Co.*, 123 U.S. 87, 98 (1887) the Court stated:

“* * * Letters-patent reissued for an invention substantially different from that embodied in the original patent are void and of no effect * * *”

In *U.S. Chemicals Co. v. Carbide*,* 315 U.S. 668 (1942), rehearing denied, 316 U.S. 708 (1942), the Supreme Court held a reissue patent invalid for failure to satisfy this requirement of the patent reissue statute on facts which bear a striking similarity to the facts of this case.

Both in the *U.S. Chemicals* case and in this case the original patent described and claimed as essential a process step which in the reissue was characterized as optional or permissive to justify broadening the patent.

In this case the patentee went even further in that during the prosecution of the original patent Proler characterized the roasting step of the process as "of major importance" (R. 446) and "to a large extent responsible for the tremendous commercial success" of the process (R. 396), and relied on the roasting step to distinguish the Proler process from the prior art (R. 379-401, 435-473).

In the *U.S. Chemicals Co.* case the Supreme Court held the reissue patent invalid for claiming an invention different from the one described in the original patent. Claim 9 of the Proler reissue patent was properly held invalid for the same reason.

The patent in the *U.S. Chemicals* case related to a process for producing ethylene oxide by subjecting ethylene to

* The *Parker and Whipple* and *U. S. Chemicals* cases were decided prior to the enactment of the Patent Act of 1952. The predecessor statute (35 U.S.C. §64) required that the patent be issued "for the same invention," while the new statute states that the patent is reissued "for the invention disclosed in the original patent." No change in the law was intended. P. J. Federico, *Commentary on the New Patent Act* 44 (1954). In both the *Parker and Whipple* and *U. S. Chemicals* cases the courts considered the entire disclosures of the original patents in determining whether the inventions thereof were the same as the inventions of the reissued patents.

the simultaneous action of the oxygen of air and of water in the presence of a catalyzer and, if need be, of hydrogen. All of the claims of the original patent included as an integral step of the process the voluntary addition of water. In the reissue patent the addition of water was stated to be optional and eliminated as an essential step of the process. At the trial expert testimony was introduced to establish that the introduction of water was immaterial and unnecessary, and the lower courts held the reissue patent in suit valid.

The Supreme Court held that the lower courts erred in relying on expert testimony introduced at the trial as to whether or not the addition of water was essential to the invention described in the original patent. The invention of the original patent is what is described and claimed in the original patent and not what the experts later conclude was the invention. The Court determined on the basis of an examination of the disclosure of the original patent that the introduction of water was described as essential in the process described in the original patent, and this was controlling over the experts' testimony that the introduction of water was not in fact essential.

The Court also took into consideration that the original patent described the introduction of water as an integral step of the process and not merely an optional or permissive step. The Court stated (page 673):

“Various options or alternatives are mentioned in the specifications, but nowhere in them, or in the claims, is the introduction of water treated as optional or permissive. The District Court made no finding directed

to this fact, but the court below definitely holds, and we agree, that, in the process defined in the original patent, the voluntary introduction of water into the reaction chamber is mandatory.”

The Court in the *U.S. Chemicals* case further stated (page 677) :

“On the face of the papers, the process described in the original patent included a step not designated as optional or desirable but described and claimed as an integral part of the whole operation.”

This is significant in the present case because certain steps were described in the original Proler patent as optional, such as trommeling and a second magnetic separation, but roasting was described as an integral step of the Proler process.

The Supreme Court concluded that the combination of steps of the process, excluding the introduction of water, in the reissue patent was for a different invention than was disclosed in the original patent where the use of water was described and claimed as an essential step. The Court held the patent invalid (page 678) :

“This court has uniformly held that the omission from a reissue patent of one of the steps or elements prescribed in the original, thus broadening the claims to cover a new and different combination, renders the reissue void, even though the result attained is the same as that brought about by following the process claimed in the original patent.”

See also, *Scovill Manufacturing Co. v. Goldblatt Brothers*, 362 F. 2d 777 (7th Cir. 1966) ; *Lockwood v. Langendorf*

United Bakeries, Inc., 324 F. 2d 82 (9th Cir. 1963); *Sears Roebuck & Co. v. Minnesota Mining & Mfg. Co.*, 243 F. 2d 136, 144 (4th Cir. 1957), cert. denied, 355 U.S. 932 (1958); *Ballew v. Watson*, 290 F. 2d 353 (D.C. Cir. 1961); *Daniel v. O. & M. Mfg. Co.*, 105 F.Supp. 336 (S. D. Tex. 1952); *Kinnear-Weed Corp. v. Humble Oil & Refining Co.*, 150 F.Supp. 143, 161 (E.D. Tex. 1956), aff'd 259 F. 2d 398 (5th Cir. 1958), cert. denied, 361 U.S. 903 (1959).

2. Roasting Is an Essential Step of the Invention Disclosed and Intended to be Covered in the Original Proler Patent

Comparison of the abandoned Proler application, the original Proler patent and the Proler reissue patent and their respective file histories brings the instant case squarely within the rationale of the *U. S. Chemicals* case.

The Court's conclusion that roasting was an essential step of the invention disclosed and intended to be covered in the original Proler patent was based on undisputed evidence that was both overwhelmingly and clearly documented:

1. The roasting step is described in the specification of the original Proler patent (and also the specifications of the abandoned Proler application and the Proler reissue patent) as an integral step in the process, and the temperature is specified as being within the range of 1300° F. to 1800° F. to burn off adhered nonferrous material such as paper, wood, grease, oil, paint, rubber and other combustibles, melting off tin and lead and other nonferrous coatings, and cracking off various porcelain and stonelike finishes (A. 5a, column 2, lines 35 through 49; R. 338).

2. In the original Proler patent of some six steps in the process two (trommeling and a second magnetic separation) are described as optional—this creates a presumption that the other four—shredding, first magnetic separation, roasting and compacting by rolls—are essential.

3. The abandoned application, the original Proler patent and the Proler reissue patent describe only a single preferred embodiment of the invention summarized in all three as follows:

“According to a preferred method embodying the invention an appropriate raw material is reduced to a proper size by milling it up until it is cut to a size that will pass a grate having openings somewhat less than a foot square, the resulting shredded material is magnetically separated, the separated more ferrous material is purified by counterflowing it through a rotary kiln heated to about 1300° to 1800° F.* at the exhaust end to melt and burn off adhered non-ferrous material, and the resulting clean scrap is compacted while still hot by rolling extrusion.” (A. 5a, column 1, lines 39 through 47; R. 338; appellant’s Ex. Y)

4. In the preferred embodiment of the Proler process the roasted scrap is compacted between the rolls 19 while still hot (A. 5a, column 1, line 47 and column 2, line 60; R. 338).

5. All of the process claims of both the abandoned application and the application which later issued as the original Proler patent contained four essential steps, namely, shredding, separating, roasting and compacting (R. 368-369, 423-424).

* C. in the abandoned application.

6. All of the claims which issued in the original Proler patent contained the same essential four steps.

7. If there still can be any doubt, the doubt is resolved by the attorneys' arguments (see Court's FF 2.3, A. 21a-24a; R. 611-615) describing the roasting step as "of major importance", "to a large extent responsible for the tremendous commercial success" of the process, and a step which distinguished the process from the other prior art patents.

On the basis of the disclosure of the original Proler patent, the history of its prosecution and the attorneys' arguments in support of patentability, it is clear from the record that roasting was disclosed as and intended to be an essential step of the invention of the original Proler patent.

This Court need not resolve by expert testimony whether in fact roasting is essential or optional in appellant's process. In the *U. S. Chemicals* case the Court disregarded expert testimony that the same result would have been obtained whether or not water was introduced. The Court looked to the record to determine whether the invention intended to be covered in the original patent included the voluntary addition of water. Here it is clear that the invention intended to be covered in the original patent included the roasting step.

Appellant cannot avoid the effect of 35 U.S.C. §251 (A. 34a) and the *U. S. Chemicals* case by the explanation that during the prosecution of the application which issued as the original Proler patent and after the citation of the Brooke patent it changed its position on the importance of the roasting step. The Patent Office record shows that even after the Brooke patent was cited appellant failed to drop the roasting step from the claims. On the contrary, the

claims containing the roasting limitation which actually issued in the original Proler patent were submitted after the citation of the Brooke patent (R. 462-465). Furthermore, the statute, 35 U.S.C. §251, and the *U. S. Chemicals* case require that the determination of whether the reissue is for the same or a different invention be made on the basis of the disclosure of the original Proler patent. Viewing the original disclosure both in respect to the specification and the claims it is apparent that roasting was disclosed as one of four essential steps. The attorneys' arguments during the prosecution of the application only resolve any doubt on the question.

Appellant points out that the specification of the original Proler patent and the Proler reissue patent are the same and that the stated objects of the invention therein do not necessarily require roasting. The rationale of the *U. S. Chemicals* case does not require a change in the reissue specification or place undue emphasis on the objects. As stated above, it is the invention that is disclosed in and intended to be covered in the original patent that controls, and not the changes made in the reissue application. It would be illogical for appellant to suggest that it is in a better position because, after dropping roasting as essential in the claims, it neglected to revise the reissue specification to describe roasting as optional.

Appellant argues that claim 9 of the Proler reissue patent meets every test laid down in *Monogram Manufacturing Co. v. Glemby*, 136 F.2d 961 (2nd Cir. 1943). In the *Monogram* case the court held that a spring was an optional and not an essential element of the original specification because (pages 963 and 964) the original specification stated

that the spring (the element eliminated by the reissue) “may be provided for clamping the end of the lock of hair” to the curling member “if desired”, “but this is not necessary.”

Appellant argues that in the *Monogram* case the court gave weight to the fact that the patentee described at the beginning of the patent in the “objects of invention” the components of the patented apparatus and did not specify that the spring was essential. The “objects of invention” of the original Proler patent are not analogous because they do not describe the patent process but are concerned with the quality, costs and characteristics of the product. In the *Monogram* case it was apparent on the face of the original disclosure that the spring was optional and not essential, whereas it is just as apparent on the face of the original Proler patent that roasting was intended to be an important and integral step of the Proler process.

Appellant quotes *Application of Handel*, 312 F.2d 943 (CCPA 1963) as holding that it is improper to look to the claims of the original patent to see what applicant intended to cover. The *Handel* case holds only that it was improper to look *solely* to the claims to make this determination. Indeed, the *Handel* case supports the appellees’ position that the entire disclosure of the original patent, including the claims, should be considered in determining whether the reissue claims a different invention. The Court stated (at page 948):

“The decisions of this court, both before and after the effective date of the 1952 act, are also to the effect, as stated in *In re DeJarlais*, 233 F.2d 323, 43 CCPA

900, 904, that 'It is also well settled that the same invention means whatever invention was described in the original patent, and which appears to have been intended to be secured thereby.' "

When the entire disclosure of the original Proler patent is considered, as appellees have urged that it should be, it is clear that roasting was disclosed as an essential step in the process intended to be covered therein, and the history of the prosecution of the application for that patent only confirms this fact.

D. Claim 9 of the Proler Reissue Patent Is Invalid on the Ground that the Defect of the Original Proler Patent Did Not Arise Through Error

Another condition for the reissue of a patent under 35 U.S.C. §251 (A. 34a) is that the original patent must be deemed inoperative or invalid "through error without any deceptive intention".

A patentee must show that the defect in his original patent resulted from "error" to be entitled to correct that defect through reissue. In *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82 (9th Cir. 1963) the Court stated at page 94:

"The right to a reissue of a patent is exceptional and is given only to those who come clearly within the exception. It must affirmatively appear in the case of a reissue patent not only that the state of the art permitted a broader claim than in the original patent, but also that the failure to claim it was due to error or inadvertence * * * When a patentee has once declared himself he is bound by the claims and drawings and

specifications set forth in this application unless he brings himself within the provisions of Sec. 251 by showing some error or inadvertence. Absent such a showing, the right to a reissue does not lie. Nor is there any presumption favoring the right to reissue."

It was not through "error" that all of the claims of the original Proler patent were limited to a process or a product made by a process which included the step of roasting the shredded scrap at a temperature sufficient to remove substantially all nonferrous material. The file histories of the abandoned Proler application and the original Proler patent show beyond dispute that the patentee relied on roasting as "of major importance" (R. 436), "to a large extent responsible for the tremendous commercial success" of the process (R. 396), and a step which distinguished the Proler process from the processes of the prior art patents (R. 379-401, 435-473). The limitation of the claims of the original Proler patent to include roasting was intentional, calculated and deliberate with full awareness of the consequences.

Proler knew precisely what roasting accomplished in his process, and he elected to emphasize the importance of roasting during the prosecution of the first and second applications which resulted in the original Proler patent. The claims of the original Proler patent as issued defined a process which included the roasting step. Proler's decision to broaden his patent by reissue was not to correct an error, but simply because he changed his mind about the importance of the roasting step. This is not a proper basis for reissue.

Appellant cites *National Nut Co. v. Sontag Chain Stores*, 107 F.2d 318 (9th Cir. 1939) as support for its contention that "error without any deceptive intention" means nothing more than lack of fraudulent intent. This construction fails to give any meaning to the word "error". The more reasonable interpretation of Section 251 is that of the more recent Ninth Circuit case of *Lockwood v. Langendorf United Bakeries, Inc.*, *supra*, in which the Court held that to comply with the reissue statute it must affirmatively appear that the failure to make the broader claim was due to error.

Where a patentee intentionally limits the claims of his original patent to stress what he believes to be a novel and distinctive feature and then changes his mind as to the importance of that feature there is no "error" within the meaning of the statute to justify reissuing the patent.

In *Daniel v. O. & M. Mfg. Co.*, 105 F.Supp. 336 (S.D. Tex. 1952), the Court held a broadening reissue patent invalid because the claims had been intentionally limited on the basis of facts known to the inventor at the time that he filed his original application for patent. The court states at page 343:

"Claims 2 through 8 of the Salzer reissue patent are *invalid* for the further reason that as a re-issue patent it was improperly issued because under the facts there is no *inadvertence*, *accident* or *mistake* which is a requisite for authorizing a re-issue patent under the statute. More specifically, there is no *inadvertence*, *accident* or *mistake* as required by the statute because that which is claimed in the re-issue patent was *known* to the inventor Salzer at the time he filed his original application for patent. He purposely

omitted disclosing in his original patent a machine *without* 'creasing elements' because he had built one, found it unsatisfactory, and had then built a machine with 'creasing elements' as *disclosed* in his patent. *Cridlebaugh v. Rudolph*, supra; *General Radio Co. v. Allen B. DuMont Laboratories, Inc.*, 3 Cir., 129 F.2d 608, 611; *Toupet-Taylor Engineering Co. v. Red Dog Mfg. & Supply Co.*, 3 Cir., 16 F.2d 454."

See also *Miller v. Brass Co.*, 104 U.S. 350, 355 (1881); *Ballew v. Watson*, 290 F.2d 353 (D.C. Cir. 1961); *Dill Mfg. Co. v. J. W. Speaker Corporation*, 83 F.Supp. 21 (E.D. Wisc. 1949), *aff'd*, 179 F.2d 278 (7th Cir. 1950).

In the absence of any error upon which the reissue of the original Proler patent could have been based, the reissue of the patent was improper and reissue claim 9 is invalid.

E. Claim 9 of the Proler Reissue Patent Is Invalid Because the Record, Including the Oath, Fails to Show Any Error

There is nothing in the entire file history of the Proler reissue patent (R. 484-517) which states the facts constituting the "error" relied on as the basis for the reissue. The only reference to the "error" is that portion of the oath filed in support of the application for the Proler reissue patent which states as follows:

"Deponent further deposes and says that the failure to include claims broad enough to properly protect the invention arose through error and without any deceptive intention on the part of Deponent, * * *

* * *

“The error in failing to include claims broadly defining the purifying step arose during the prosecution of the application for the patent, and was not discovered until after the patent had issued, in a conversation between applicant and his attorney on November 17, 1960” (R. 495-496).

The Commissioner of Patents erred in accepting the oath couched in the general terms of the statute. The oath should have set forth the facts to show that error was actually committed and how the error arose.

As was stated in *General Radio Co. v. Allen B. DuMont Laboratories*, 129 F.2d 608, 612 (3d Cir. 1942), cert. denied 317 U.S. 654 (1942):

“We are satisfied that an applicant who wishes to obtain the benefits of the reissue statute must make a specific showing of the circumstances from which the conclusion of inadvertence, accident or mistake may be drawn by the Commissioner and that he does not comply with the statute by a mere sworn averment couched in the statutory terms or by a showing that the patentee or his solicitors committed an error of judgment.”

See also, *Lockwood v. Langendorf United Bakeries, Inc.*, *supra*, p. 47.

The Commissioner of Patents was without authority to reissue the original Proler patent by reason of the defective oath filed in support thereof which failed to show any error or how the error arose, and therefore claim 9 of the Proler reissue patent is invalid.

Appellant excuses the absence of any affirmative statement in the record as to how the error arose on the grounds

that 1) the reissue statute does not require an oath, and 2) *Fehr v. Activated Sludge*, 84 F.2d 948 (7th Cir. 1936), holds that a deficient oath can be supplemented by additional evidence to show the error and how it arose.

Rule 175 of the Rules of the United States Patent Office in Patent Cases requires an oath accompanying a reissue application * * * “(4) Particularly specifying the errors relied on and how they arose or occurred.” The oath, therefore, is the proper vehicle for showing the existence of error and how the error arose.

Regardless of whether or not the reissue statute requires an oath and whether or not the oath can be supplemented by additional evidence, it is clear that the record of the proceedings in the Patent Office must affirmatively show the error and how it arose. The record in the Proler reissue patent shows that the failure to include a claim without roasting was due to the intentional stress placed on the step in the original disclosure and during the prosecution of the application for the original Proler patent. The record clearly shows that there was no error, and it follows that it also fails to show how the error arose.

V. SUMMARY JUDGMENT WAS PROPERLY GRANTED

The Court below recognized that summary judgment could be granted in favor of appellees on all five grounds without the need for expert testimony and without the necessity of resolving any disputed fact. The Court concluded on the basis of the undisputed facts and upon proper

construction of claim 9 of the Proler reissue patent, the prerogative of a court and not of a jury when the evidentiary facts are not in dispute, that there was no infringement of the claim by appellees, and that the claim is invalid.

In the absence of a genuine issue of material fact involved in the adjudication of issues which are dispositive of patent infringement cases, the Supreme Court and the courts in the Ninth Circuit have found summary judgment to be a proper basis for disposing of patent infringement and validity. *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143 (1942); *Henderson v. A.C. Spark Plug Div. of General Motors Corp.*, 366 F.2d 389 (9th Cir. 1966); *Rankin v. King*, 272 F.2d 254 (9th Cir. 1959); *Englehard Industries v. Research Instrumental Corp.*, 324 F.2d 347 (9th Cir. 1963), cert. denied, 377 U.S. 923 (1964); *Indiana General Corp. v. Lockheed Aircraft Corp.*, 249 F. Supp. 809 (S.D. Calif. 1966); *Riley v. Broadway-Hale Stores, Inc.*, 114 F. Supp. 884 (S.D. Calif. 1953), aff'd, 217 F.2d 530 (9th Cir. 1954); *Dolgoff v. Kaynar Company*, 18 F.R.D. 424 (S.D. Calif. 1955).

In *Cee-Bee Chemical Co. v. Delco Chemical Co.*, 263 F.2d 150 (9th Cir. 1958), and other cases relied on by appellant, the existence of a genuine issue of material fact precluded the courts from granting summary judgment. In this case appellant has not shown that there is an issue with respect to any of the facts on which the Court below granted summary judgment. As was stated in the *Henderson* case, *supra*, at p. 393:

“The mere statement that ‘an issue exists’ does not prevent the granting of a summary judgment below.

To abide by such a rule would emasculate the statute permitting such judgments.”

The Court below in the absence of any disputed controlling facts properly and correctly ruled as a matter of law that the claim 9 of the Proler reissue patent was invalid and not infringed. In granting appellees’ motion for summary judgment the Court below heeded the admonition of this Court in the *Henderson* case, *supra*, at p. 394:

“It is the duty of the trial court to dismiss a patent suit when the necessary showing is made on a motion for a summary judgment.”

See also, *Barkeij v. Lockheed Aircraft Corp.*, 210 F.2d 1, 2 (9th Cir. 1954).

VI. CONCLUSION

Appellant has not shown that the Court below resolved any controlling issue of fact or failed to consider any material fact in adjudging claim 9 of the Proler reissue patent invalid and not infringed by appellees. Appellees respectfully submit that the judgment was properly granted and should be affirmed.

Respectfully submitted,

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I certify that, in connection with the preparation of this brief, I have examined Rules 18, 19 and 39 of the United States Court of Appeals for the Ninth Circuit, and that in my opinion the foregoing brief is in full compliance with those rules.

This is to certify that three copies of this brief have been served on counsel for the appellant by mailing them to their addresses of record.

MAX K. JAMISON